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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/199,655	11/25/1998	RICHARD A. MATHIES	104464-0002	3941

37403 7590 05/11/2006

ATTENTION: MICHAEL VERGA  
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FAIRFAX, VA 22030

EXAMINER
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GORDON, BRIAN R

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 05/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/199,655

Applicant(s)

MATHIES ET AL.

Examiner

Brian R. Gordon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 1-29-03 (in view of granted petition).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 41-55 is/are pending in the application.
- 4a) Of the above claim(s) 47-55 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 41-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 29, 2003 has been entered.

### ***Election/Restrictions***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claims 41-46, drawn to a liquid handling system, classified in class 422, subclass 100.
  - II. Claims 47-55, drawn to a method of transferring liquid, classified in class 436, subclass 180.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus is not limited to the practice of the method and the method does not require the particulars of the device as claimed to perform the process.

4. Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.
5. Because these inventions are independent or distinct for the reasons given above and the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.
6. Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
7. During a telephone conversation with Michael G. Verga on May 8, 2006 a provisional election was made with traverse to prosecute the invention of Group I, claims 41-46. Affirmation of this election must be made by applicant in replying to this Office action. Claims 47-55 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.
8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

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art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claim 43-46 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for including temperature control devices of the group of claim 43, does not reasonably provide enablement for a cooler being defined as one of the elements of the group (see page 12, line 3 of specification). The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. The elements within the group are not all capillary coolers as claimed. While all of the elements may be used to control the temperature all of the elements are not described as capable of cooling devices. For example, a resistive heating system is not cooler. Moreover, the elements are not described as elements sufficient for capture methods as specified by applicant the elements of the group are temperature control devices. The stop methods are disclosed as employing the cooler 119 and other stop methods disclosed (beginning at page, line 16).

The first and second container should be positively claimed for the other elements are claimed in relevance to their structural relationship with the containers.

11. Claims 41-46 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant has provided new claims but has not provided remarks that state where support for the new claims are provided within the original specification. The examiner hereby considers the claimed material as new matter.

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claims 41-46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear which elements applicant considers as being elements of the apparatus. It is unclear if the first and second containers are elements of the invention. While mentioned in the claimed the elements are not positively claimed as they were in the previous versions of the claims. The only required elements are a plurality of capillary tubes, pressure housing, and liquid stop.

It is further unclear what is a stop mechanism. What does the mechanism stop?

Claim 45 is not further structurally limiting for in claim 45 the cooling fluid or gas is not positive claimed as elements of the invention.

### ***Claim Rejections - 35 USC § 102***

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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15. Claim 41 is rejected under 35 U.S.C. 102(b) as being anticipated by Citrin US 4,058,146.

Citrin discloses a system for accurately transferring similar small amounts of liquid from a multiplicity of containers (first container) to a corresponding multiplicity of wells in a microtitration test plate (second container) includes a multiplicity of conduits (capillaries) leading from a pressure chamber (housing) enclosing the containers and to which conduits the containers are individually automatically connected when the containers are loaded into the system, the conduits leading to a pinch type dispensing valve (stop mechanism) disposed above the test tray (abstract).

***Claim Rejections - 35 USC § 103***

16. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

17. Claims 42-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Citrin as applied to claim 41 above, and further in view of Nordman et al. US 6,387,236.

Citrin does not disclose the inclusion of a temperature control/cooling system.

Nordman et al. discloses a capillary liquid transfer device that optionally includes a computer to control the functions of the device and for data collection and analysis, a detector for detecting samples in the cuvette, and a temperature control device for controlling the temperature of the capillary tubes and cuvette. Details of these and other common features of an operable capillary electrophoresis device may be found in any number of available publications.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the device of Citrin to incorporated a common temperature control device, for temperature and pressure are directly related as such the pressure within the device may be further regulated.

### ***Conclusion***

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hunter, Ian et al.; Xiao, Jianming et al.; Chen; Shiping et al.; Borrelli; Nicholas F. et al.; Taylor; Todd A. et al.; Doktycz; Mitchel J. et al.; Webb; Leslie; Nordman; Eric S. et al.; Kaltenbach; Patrick et al.; Wilson; Richard K. et al.; Kenney; James W.; Stewart, Lansing J. et al.; Koike; Toshio; and Berndt, Manfred disclose various fluid transfer devices.

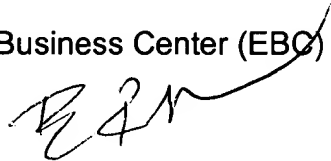
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian R. Gordon whose telephone number is 571-272-1258. The examiner can normally be reached on M-F, with 2nd and 4th F off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to be "EBC", is written over the text "Electronic Business Center (EBC)".

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